

REMARKS

Summary of the Office Action

1. Claims 1, 16, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels (U.S. Patent No. 5,270,821) in view of Ike (U.S. Patent No. 5,153,765) and Reber (U.S. Patent No. 6,002,946), and Kawasugi Stephan (U.S. Patent No. 5,703,616).
2. Claims 6 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels in view of Ike and Rever and Kawasugi as applied to claims 1 and 16, and further in view of Carroll. (U.S. Patent No. 6,121,960).
3. Claims 32-35 are rejected under 25 U.S.C. 103(a) as being unpatentable over Samuels in view of Ike, Stephan and Carroll.
4. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels in view of Rever and Kawasugi.
5. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels in view of Rever and Kawasugi as applied to claim 36 and in further view of Carroll.

Summary of the Response

Claim 36 has been amended. None of the claims have been added or canceled. Hence, the now pending claims are 1, 6, 16, 26, 29, 30, and 32-38.

Claim 36

Claim 36 recites:

in response to user operation of a mechanical button disposed on the PDA,
launching a first application that displays a graphical user-interface on the
image screen disposed on a personal data assistant; and
receiving user input on the image screen to manipulate the user interface; and

adjusting the brightness or the contrast based on the input.

Claim 36 requires "receiving user input **on the** image screen to manipulate the user interface" and "adjusting the brightness or the contrast based on the input." The combination of these limitations is not suggested in any way by the cited art.

The claimed invention was motivated, at least in part, by a problem involving the inadvertent adjustment of brightness or contrast controls on some PDAs. Brightness and contrast of an image screen on some PDAs are adjusted using mechanical sliders and wheels disposed on the PDA. These input means were often inadvertently manipulated when sliding a PDA in and out of a pocket or other container. Claim 36 describes an approach that is not necessarily susceptible to such inadvertent manipulation. Input for controlling the brightness or contrast is entered through physical contact with an image screen over a graphical user-interface element displayed on the image screen. This form of input is referred to herein as touch screen input.

In rejecting claim 36, the Office Action has alleged the combination of Samuel in combination with Reber and Kawasugi discloses all limitations in the claims. In order for a combination of references to be proper under 35 USC 103, there must be a motivation to combine the references in a manner that results in the claimed invention. For example, MPEP 2143.01, (under the title "THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION") states, "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so.... *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing

the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).”

Although the Office Action attempts to provide motivations for the combination posited, the motivations provided are deficient for the reasons explained below.

The Office Action fails to make particular factual findings regarding the locus of the suggestion, teaching, or motivation to combine prior art references.

The Office Action must make particular factual findings regarding the locus of the suggestion, teaching, or motivation to combine prior art references.

As stated in the Federal Circuit decision *In re Dembiczak*, 50 USPQ.2d 1617 (Fed. Cir. 1999), (citing *Gore v. Garlock*, 220 USPQ 303, 313 (Fed. Cir. 1983)), “it is very easy to fall victim to the insidious effect of the hindsight syndrome where that which only the inventor taught is used against its teacher.” *Id.* The Federal Circuit stated in *Dembiczak* “that the best defense against subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or suggestion to combine prior art references.” *Id.* Thus, the Federal Circuit explains that a proper obviousness analysis requires “***particular factual findings regarding the locus of the suggestion, teaching, or motivation*** to combine prior art references.” *Id.* (emphasis added).

In particular, the Federal Circuit states:

“We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved...although ‘the suggestion more often comes from the teachings of the pertinent references’...The range of sources available, however, does ***not diminish the***

requirement for actual evidence. That is, the **showing must be clear and particular**...Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *Id.* (emphasis added; internal citations omitted).

The Office Action states that it would have been obvious to one having ordinary skill in the art to combine Samuels with Reber and Kawasugi, the motivation being that "by allowing such an arrangement, the user does not have to manipulate the cursor and position the cursor over the scroll bars in order to change the display parameters thereby providing a more direct control for adjusting the display parameters." While the Office Action alleges a motivation, the Office Action fails to allege any particular finding about the location of the motivation posited. It is respectfully submitted the Office Action fails to meet Federal Circuit's requirement for "particular factual findings" about the "locus" of the motivation.

The cited art fails to teach any motivation to add touch screen input capability to the display device of Samuels to control brightness or contrast.

Samuels, Reber and Kawasugi fail to teach any motivation to combine them. This fact explains why the Office Action failed to allege particular findings regarding a locus of a motivation to combine.

Specifically, the cited art fails to provide a motivation to modify the input means for modifying brightness and contrast of Samuels by adding touch screen input capability. The cited art does not suggest that the display video in Samuels suffers from inadvertent manipulation. Further, the cited art fails to suggest that the input means of Samuels has a deficiency that is alleviated by touch screen input technology or that touch screen technology provides a benefit over and above that provided by the input means taught by Samuels. Likewise, Kawasugi fails to mention its display contrast control

suffers from any deficiency that is alleviated by touch screen input technology or that touch screen technology provides a benefit over and above that provided by the input means taught by Kawasugi. Finally, Reber fails to mention anything about controlling brightness and contrast, and therefore fails to teach a motivation for modifying an input means controlling brightness and contrast.

The proposed modification changes the principle of operation of the primary reference and therefore cannot be used to show obviousness.

The Office Action posits modifying Samuels to incorporate features not taught by Samuels but that are taught, allegedly, by Reber and Kawasugi. Presumably, the Office Action has equated the PDA to which an image screen is disposed to the video display and micro-controller taught by Samuels, and the graphical user interface elements to the “on-screen menu” controlled by the micro-controller. In Samuels, the input means for controlling the on-screen menu and brightness and contrast is either a four switch front panel, which may be manipulated by a user, or a PC interface. (col. 5, lines 20 – 31) Presumably, the modification posited by the Office Action replaces the cathode ray display of Samuels with a touch screen and replaces the input means of Samuels with one that uses touch screen input. The touch screen input capability not only represents a substantial cost increase but also a completely different manner of operation for the cathode ray tube technology used by the video display of Samuels. A proposed modification cannot change the manner of operation in which the original device was intended to function (See MPEP 2143.01, p. 2100-127, the right column, entitled, “THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE,” which cites *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Because the modification proposed by the Office Action changes the

principle of operation of Samuels, Samuels cannot be used in combination with any other references to establish obviousness.

Based on the foregoing reasons, it is respectfully submitted that claim 36 is allowable. Reconsideration and allowance of claim 36 is respectfully requested.

Claims 1 and 16

Claims 1 and 16 require a personal data assistant (PDA) having the following features:

(1) detecting user interaction with a graphical user interface element by detecting contact on an image screen over the graphical user interface element,

(2) adjusting the brightness or contrast of the image screen based on detecting the user interaction; and

(3) displaying the user graphical user interface element on the image screen in response to an activation signal, where the displaying is caused by a process running on the PDA under the control of an operating system.

For reasons discussed with respect to claim 36, the Office Action fails to show that the combination of (1) detecting user interaction with the graphical user interface element by detecting contact on the screen over the graphical user interface element, and (2) adjusting the brightness or contrast of the image screen based on detecting the user interaction. In addition, the cited art fails to show that the combination of (2) adjusting the brightness or contrast of the image screen based on detecting the user interaction, and (3) displaying of the user graphical user interface element on the image screen in

response to an activation signal, where the displaying is caused by a process running on the PDA under the control of an operating system, is obvious.

The Office Action posits to modify the video display of Samuels by adding the capability of running an operating system and process that controls the aforementioned displaying. However, modifying Samuels by adding this capability changes an important principle of operation of Samuels. That principle of operation is that a process controlled by an operating system that controls brightness and contrast on the display video executes externally on a PC and controls the brightness and contrast through the PC interface.

Adding an operating system capability to the video display to control a process that can display a user interface changes this principle of operation. The principle of operation is an important one. It allows programmatic control by a PC and makes available the power and versatility of the PC to provide input (including the power and versatility of input via GUIs, wireless mouse, and voice input) to control brightness and contrast via the PC interface, without having to undergo the expense of creating a display device with such capabilities.

Furthermore, adding an operating system capability to the video display represents a significant cost increase. If one of ordinary skill expects that a proposed modification to a device that provides no benefit for a device that could not be obtained using existing mechanisms on the device (i.e. the PC interface), but that substantially increases the device's cost, it logically follows that there is in fact no motivation for the proposed modification.

Based on the foregoing, reconsideration and allowance of claims 1 and 16 is respectfully requested.

Claim 32

Claim 32 requires the features (1) – (3) enumerated above for claims 1 and 16. For reasons similar to those given for claims 1 and 16, the art cited as rendering claims 1 and 16 obvious fails to render claim 32 unpatentable. Reconsideration and allowance of claim 32 is respectfully requested.

Dependant Claims

The pending claims not discussed so far are dependant claims that depend on an independent claim that is discussed above. Because each of the dependant claims include the limitations of claims upon which they depend, the dependant claims are patentable for at least those reasons the claims upon which the dependant claims depend are patentable. Removal of the rejections with respect to the dependant claims and allowance of the dependant claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable. Due to the fundamental difference already identified, a separate discussion of those limitations is not included at this time.

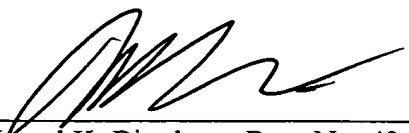
CONCLUSION

Accordingly, a Notice of Allowance is requested by Applicants. Should any issues preclude allowance of this application, Applicant urges the Examiner to telephone Applicants' attorney at (408) 414-1206. The Office is given permission to charge any unpaid fees to Applicants' deposit account (50-1302).

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On September 7, 2004

By


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